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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0026119.0136EUS1	
		Application Number 09/697,024-Conf. #3438	Filed October 25, 2000
		First Named Inventor John B. CONSTANTINE et al.	
		Art Unit 3627	Examiner J. A. Fischetti
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,120</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p style="text-align: right;">  Signature <u>Ira H. Donner</u> Typed or printed name <u>(212) 230-8800</u> Telephone number <u>11/16/06</u> Date </p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>			
<input type="checkbox"/> Total of <u>1</u> forms are submitted.			

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.

Dated: 11/16/06 Signature: Ira H. Donner (Ira H. Donner)

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Attorney Docket No. 26119.136E-US1

NOV 16 2006**PATENTS****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Bob Lamoureux et al. Confirmation No. 3438
Application No. : 09/697,024 Group Art Unit: 3627
Filed : October 25, 2000 Examiner: Joseph A. Fischetti
For : ELECTRONIC COMMERCE INFRASTRUCTURE SYSTEM

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Commissioner for Patents
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PRE-APPEAL BRIEF

In response to the Advisory Action mailed October 30, 2006 and in response to the Final Office Action mailed May 17, 2006 ("the Final Action"), Applicants submit a Notice of Appeal, and the following Pre-Appeal Brief Request for Review.

Restriction History

The present application is related to U.S. Application number 09/696,754 ("the '754 application") and U.S. Application number 09/696,765 ("the '765 application").

The '754 application was filed with 58 claims, which were restricted into 7 inventions. After 16 new claims were added, further restriction was required, among 3 groups of inventions. The '765 application was filed with 32 claims and has been restricted into 5 inventions with one of the inventions having seven distinct species. The present Application was filed with 43 claims and the Examiner required restriction and listed nine groups of inventions.

Thus, between the three related applications, it appears that the Examiner has found 30 groups of patentably distinct subject matter. Claims 12-33 of the present application are at least twice rejected. Applicants respond to the rejections below.

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REMARKS

I. Rejection Under 35 U.S.C. § 103

Claims 12-33 are rejected as obvious in view of, Bowman (U.S. Patent 6,601,234: Attribute dictionary in a business logic services environment) and Frey (U.S. Patent 6,029,168: Decentralized file mapping in a striped network file system in a distributed computing environment). Applicants respectfully disagree.

A. What The Examiner Believes to be a Data Element Reference Is Not Identified by the Examiner in the Prior Art

Applicants noted in the second to last paragraph of page 9 of the Final Reply (Amendment Filed October, 16 2006), that the Examiner does not explicitly state what element of Bowman he believes to correspond the "meta data" of claim 12, in the Examiner's rejection of claim 12 on page 3 of the Final Action. It appears, however, that the Examiner attempts to illustrate that meta data is bundled when he states that "each data stream 'includes an attribute descriptor defining elements of the data.'" The Examiner then states that the bundle of Bowman "consists of a data element reference and meta data describing the data," without giving any indication of what corresponds to the required "data element reference" (Final Action Page 3).

B. The Portions of Bowman Relied on by the Examiner are Contrary to his Conclusion

Applicants asserted in the last paragraph of page 9 through the second paragraph of page 10 of the Final Reply, that Bowman does not show or suggest bundling together a data element reference and a meta data describing the data element. Applicants also made this argument on page 10 of the February Reply (Amendment Filed February 16, 2006). In response, the Examiner alleged in the Final Action, that Bowman shows the contrary. However, Bowman clearly illustrates the Applicants contention that a reference is not being bundled in Bowman. As quoted by the Examiner on page 7 of the Office Action, Bowman states "it is best to bundle all the necessary data into a single data structure" and "the business object bundles all the data into a data structure." Bowman is clearly explaining here that the data itself is being bundled and not a "reference" to the data as required by claim 12. Detailed arguments are presented in the last paragraph of page 9 through the second paragraph of page 10 of the Final Response.

C. The "Distributing" Feature Is Not Shown or Suggested by any Combination of the Prior Art

In last paragraph of page 10 of the Final Reply, Applicants noted that the Examiner did not reply to the Applicants' assertion, in page 10 of the February Reply, that Frey is not involved in "distributing," as claim 12 requires, but instead is merely involved in downloading data. However, the Examiner did state that, "Bowman is not being relied on for the distributing feature recited in the last paragraph of claim 12." Instead "Frey is

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relied on for teaching using the meta data ... to distribute copies of the data to nodes of accessors." However, **Frey** does not show or suggest, "distributing the meta data from the bundles through the network."

Detailed arguments are presented in last paragraph of page 10 through the end of page 11 of the Final Response. However, in summary, **Frey is searching for a file in a list and then accessing the file.** Frey access the list, looks for a file, and then **pulls** the file. While the claimed invention can, for example, **distribute meta data** (e.g. a file name) through the network and then when **an accessor selects that meta data**, the invention can **distribute the data**. The claimed invention can **push** information about a file, an accessor can select it, and then a copy can be distributed to the accessor.

D. The Examiner Has Not Followed the Requirements of MPEP § 2144.03 Because He Has Not Properly Responded to the Applicant's Challenge of Office Notice

As noted at the top of page 12 of Final Response, the Examiner stated on page 10 of the Final Office Action that "the following references are cited" (emphasis added) in response to "the official notice [being] challenged." However, the Examiner then cited only one reference, Fisher. The Examiner noted that Fisher is being cited in relation to claim 14. However, Regarding claims 29 and 30, the Examiner cites "col. 16 lines 17-20," but provides no indication what reference is being referred to. Despite the lack of indication of prior art reference, the Applicants considered the possibility that the Examiner intended to cite Fisher here as well. However, col. 16 lines 17-20 of Fisher appear completely unrelated to claims 29 and 30. Additionally, the applicants reviewed the Examiner's stated reasons for rejecting claims 29 and 30. These rejections, however, have not been altered from the previous Office Action and continue to cite only Official Notice. Therefore, it cannot be determined what reference the Examiner has relied on in the rejection of claims 29 and 30.

Accordingly, Applicants have not been "presented with the explicit basis on which the examiner regards the matter as subject to official notice" and have therefore not been "allowed to challenge the assertion" as required by the MPEP § 2144.03. Applicants point out that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as principal evidence upon which the rejection was based" (MPEP § 2144.03 E).

Applicants informed the Examiner of this in paragraphs one and two of page 12 of the Final Reply and requested an affidavit under 37 C.F.R. § 1.104(d)(2) detailing the reasons it is well known to be provided, or a prior reference showing these features be provided. Nothing further was provided.

E. The Examiner Has Not Made a Prima Facie Case of Obviousness for Claim 14

As discussed in section IV, starting on page 12 of the Final Response, claim 14 recites, "negotiating a trusted relationship between owners and accessors to define the security information." The Examiner had taken

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Official Notice regarding this claim and in response to the Applicants request to be presented with an explicit basis, in the February Reply, the Examiner provided Fisher. However, it is unclear if the examiner is relying on Fisher in a rejection under 35 USC §103 in combination with Bowman and Frey because the original rejection has not been altered. However, assuming he is relying on that combination, the Examiner has not provided any indication of a motivation to combine Fisher with Bowman and/or Frey. Applicants informed the Examiner of this in first paragraph of page 13 of the Final Response. The Examiner did not provide any motivation in response to this.

F. Inherency Is Misapplied Regarding Claims 13 and 15

The Examiner states that the Applicants argument that inherency cannot be used in an obviousness rejection **directly conflicts** with MPEP Section 2112. The Examiner admits that the features of dependent claims 13 and 15 are in fact subject to an obviousness rejection. Specifically, inherency and obviousness are separate and unrelated concepts. Detailed argument are provided in section V, starting at page 13, of the Final Response.

G. The Suggested Motivation to Combine Bowman and Frey is Improper

The Examiner states, on page 4 of the Final Office Action, that it

"would be obvious to modify Bowman 234 to associate each bundle with a node and to assemble same there at in order to effect a node associated bundle and to copy the data elements to a user computer using a selection process such as the directory in Frey, the motivation being the ability to make changes to the data resident at the user's node and to allow access to information."

Applicants noted, for example, on page 15 of the Final Reply, that Applicants respectfully disagree and assert that there is no motivation to combine Bowman and Frey to produce the claimed invention. When claim 12 is interpreted as a whole, the prior art does not show or suggest the combination of limitations in claim 12. For example, neither Bowman nor Frey discloses the claimed step of "assembling information into bundles, wherein **each bundle comprises a data element reference and meta data describing the data element.**" Therefore, no combination of Bowman and Frey could arrive at the combination of elements in claim 12.

II. Rejections Under 35 USC § 112, Second Paragraph

In the Final Action, claims 28, 31, and 33 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants considered the claims as being sufficiently clear and proper under 35 USC § 112. Nevertheless, Applicant amended the claims in the Final Response.

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With respect to claim 28, Applicants believe the claim was clear and met the requirements of 35 USC § 112, second paragraph. Specifically, the bundle version identifier is used, in at least one embodiment, to provide the ability to determine the current version of the data element and/or copy of the data element, as described in the specification. However, Applicants amended claim 28 to include, for example, "wherein there is a plurality of versions of at least one of the bundles and wherein each of the plurality of versions is identified by a bundle version identifying signal."

With respect to claim 31, Applicant believes this claim was clear and met the requirements of 35 USC § 112, second paragraph. However, Applicants amended claim 31 to remove, for example, "peer-to-peer access to the data elements referenced in the bundles" and add "wherein the network node of the data owners and at least one of the network nodes of the accessors each stores the copies and wherein the network node of the data owners and at least one of the network nodes of the accessors each have access to the data elements referenced in the bundles."

With respect to claim 33, Applicant believes that this claim was clear and met the requirements of 35 USC § 112, second paragraph. Specifically, content blending is described in the specification as being used, in at least one embodiment, to create custom content collections based on bundle type, author, recipients, destination device or other criteria.

Applicants believe these claims are definite and are proper claims under 35 USC § 112. Detailed arguments are presented on pages 7 and 8 of the Final Response.

Furthermore, the Examiner has not entered the proposed amendments because they "raise new issues" (Advisory Action, page 2). Applicants assert that these claims should be entered because they do not raise new issues and because they would place the Application in better form for appeal.

Respectfully submitted,

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